



Copyright, Designs and Patents Act 1988

1988 CHAPTER 48

PART V

PATENT AGENTS AND TRADE MARK AGENTS

Patent agents

274 Persons permitted to carry on business of a patent agent

- (1) Any individual, partnership or body corporate may, subject to the following provisions of this Part, carry on the business of acting as agent for others for the purpose of—
 - (a) applying for or obtaining patents, in the United Kingdom or elsewhere, or
 - (b) conducting proceedings before the comptroller relating to applications for, or otherwise in connection with, patents.
- (2) This does not affect any restriction under the European Patent Convention as to who may act on behalf of another for any purpose relating to European patents.

275 The register of patent agents

- (1) The Secretary of State may make rules requiring the keeping of a register of persons who act as agent for others for the purposes of applying for or obtaining patents; and in this Part a “registered patent agent” means a person whose name is entered in the register kept under this section.
- (2) The rules may contain such provision as the Secretary of State thinks fit regulating the registration of persons, and may in particular—
 - (a) require the payment of such fees as may be prescribed, and
 - (b) authorise in prescribed cases the erasure from the register of the name of any person registered in it, or the suspension of a person’s registration.
- (3) The rules may delegate the keeping of the register to another person, and may confer on that person—
 - (a) power to make regulations—

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- (i) with respect to the payment of fees, in the cases and subject to the limits prescribed by rules, and
 - (ii) with respect to any other matter which could be regulated by rules, and
 - (b) such other functions, including disciplinary functions, as may be prescribed by rules.
- (4) Rules under this section shall be made by statutory instrument which shall be subject to annulment in pursuance of a resolution of either House of Parliament.

276 Persons entitled to describe themselves as patent agents

- (1) An individual who is not a registered patent agent shall not—
- (a) carry on a business (otherwise than in partnership) under any name or other description which contains the words “patent agent” or “patent attorney”; or
 - (b) in the course of a business otherwise describe himself, or permit himself to be described, as a “patent agent” or “patent attorney”.
- (2) A partnership shall not—
- (a) carry on a business under any name or other description which contains the words “patent agent” or “patent attorney”; or
 - (b) in the course of a business otherwise describe itself, or permit itself to be described as, a firm of “patent agents” or “patent attorneys”,
- unless all the partners are registered patent agents or the partnership satisfies such conditions as may be prescribed for the purposes of this section.
- (3) A body corporate shall not—
- (a) carry on a business (otherwise than in partnership) under any name or other description which contains the words “patent agent” or “patent attorney”; or
 - (b) in the course of a business otherwise describe itself, or permit itself to be described as, a “patent agent” or “patent attorney”,
- unless all the directors of the body corporate are registered patent agents or the body satisfies such conditions as may be prescribed for the purposes of this section.
- (4) Subsection (3) does not apply to a company which began to carry on business as a patent agent before 17th November 1917 if the name of a director or the manager of the company who is a registered patent agent is mentioned as being so registered in all professional advertisements, circulars or letters issued by or with the company’s consent on which its name appears.
- (5) Where this section would be contravened by the use of the words “patent agent” or “patent attorney” in reference to an individual, partnership or body corporate, it is equally contravened by the use of other expressions in reference to that person, or his business or place of business, which are likely to be understood as indicating that he is entitled to be described as a “patent agent” or “patent attorney”.
- (6) A person who contravenes this section commits an offence and is liable on summary conviction to a fine not exceeding level 5 on the standard scale; and proceedings for such an offence may be begun at any time within a year from the date of the offence.
- (7) This section has effect subject to—
- (a) section 277 (persons entitled to describe themselves as European patent attorneys, &c.), and

- (b) section 278(1) (use of term “patent attorney” in reference to solicitors).

277 Persons entitled to describe themselves as European patent attorneys, &c

- (1) The term “European patent attorney” or “European patent agent” may be used in the following cases without any contravention of section 276.
- (2) An individual who is on the European list may—
 - (a) carry on business under a name or other description which contains the words “European patent attorney” or “European patent agent”, or
 - (b) otherwise describe himself, or permit himself to be described, as a “European patent attorney” or “European patent agent”.
- (3) A partnership of which not less than the prescribed number or proportion of partners is on the European list may—
 - (a) carry on a business under a name or other description which contains the words “European patent attorneys” or “European patent agents”, or
 - (b) otherwise describe itself, or permit itself to be described, as a firm which carries on the business of a “European patent attorney” or “European patent agent”.
- (4) A body corporate of which not less than the prescribed number or proportion of directors is on the European list may—
 - (a) carry on a business under a name or other description which contains the words “European patent attorney” or “European patent agent”, or
 - (b) otherwise describe itself, or permit itself to be described as, a company which carries on the business of a “European patent attorney” or “European patent agent”.
- (5) Where the term “European patent attorney” or “European patent agent” may, in accordance with this section, be used in reference to an individual, partnership or body corporate, it is equally permissible to use other expressions in reference to that person, or to his business or place of business, which are likely to be understood as indicating that he is entitled to be described as a “European patent attorney” or “European patent agent.”

278 Use of the term “patent attorney”: supplementary provisions

- (1) The term “patent attorney” may be used in reference to a solicitor, and a firm of solicitors may be described as a firm of “patent attorneys”, without any contravention of section 276.
- (2) No offence is committed under the enactments restricting the use of certain expressions in reference to persons not qualified to act as solicitors—
 - (a) by the use of the term “patent attorney” in reference to a registered patent agent, or
 - (b) by the use of the term “European patent attorney” in reference to a person on the European list.
- (3) The enactments referred to in subsection (2) are section 21 of the Solicitors Act 1974, section 31 of the Solicitors (Scotland) Act 1980 and Article 22 of the Solicitors (Northern Ireland) Order 1976.

279 Power to prescribe conditions, &c. for mixed partnerships and bodies corporate

- (1) The Secretary of State may make rules—
 - (a) prescribing the conditions to be satisfied for the purposes of section 276 (persons entitled to describe themselves as patent agents) in relation to a partnership where not all the partners are qualified persons or a body corporate where not all the directors are qualified persons, and
 - (b) imposing requirements to be complied with by such partnerships and bodies corporate.
- (2) The rules may, in particular—
 - (a) prescribe conditions as to the number or proportion of partners or directors who must be qualified persons;
 - (b) impose requirements as to—
 - (i) the identification of qualified and unqualified persons in professional advertisements, circulars or letters issued by or with the consent of the partnership or body corporate and which relate to it or to its business; and
 - (ii) the manner in which a partnership or body corporate is to organise its affairs so as to secure that qualified persons exercise a sufficient degree of control over the activities of unqualified persons.
- (3) Contravention of a requirement imposed by the rules is an offence for which a person is liable on summary conviction to a fine not exceeding level 5 on the standard scale.
- (4) The Secretary of State may make rules prescribing for the purposes of section 277 the number or proportion of partners of a partnership or directors of a body corporate who must be qualified persons in order for the partnership or body to take advantage of that section.
- (5) In this section “qualified person”—
 - (a) in subsections (1) and (2), means a person who is a registered patent agent, and
 - (b) in subsection (4), means a person who is on the European list.
- (6) Rules under this section shall be made by statutory instrument which shall be subject to annulment in pursuance of a resolution of either House of Parliament.

280 Privilege for communications with patent agents

- (1) This section applies to communications as to any matter relating to the protection of any invention, design, technical information, trade mark or service mark, or as to any matter involving passing off.
- (2) Any such communication—
 - (a) between a person and his patent agent, or
 - (b) for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his patent agent,is privileged from disclosure in legal proceedings in England, Wales or Northern Ireland in the same way as a communication between a person and his solicitor or, as the case may be, a communication for the purpose of obtaining, or in response to a request for, information which a person seeks for the purpose of instructing his solicitor.

- (3) In subsection (2) “patent agent” means—
- (a) a registered patent agent or a person who is on the European list,
 - (b) a partnership entitled to describe itself as a firm of patent agents or as a firm carrying on the business of a European patent attorney, or
 - (c) a body corporate entitled to describe itself as a patent agent or as a company carrying on the business of a European patent attorney.
- (4) It is hereby declared that in Scotland the rules of law which confer privilege from disclosure in legal proceedings in respect of communications extend to such communications as are mentioned in this section.

281 Power of comptroller to refuse to deal with certain agents

- (1) This section applies to business under the Patents Act 1949, the Registered Designs Act 1949 or the Patents Act 1977.
- (2) The Secretary of State may make rules authorising the comptroller to refuse to recognise as agent in respect of any business to which this section applies—
- (a) a person who has been convicted of an offence under section 88 of the Patents Act 1949, section 114 of the Patents Act 1977 or section 276 of this Act;
 - (b) an individual whose name has been erased from and not restored to, or who is suspended from, the register of patent agents on the ground of misconduct;
 - (c) a person who is found by the Secretary of State to have been guilty of such conduct as would, in the case of an individual registered in the register of patent agents, render him liable to have his name erased from the register on the ground of misconduct;
 - (d) a partnership or body corporate of which one of the partners or directors is a person whom the comptroller could refuse to recognise under paragraph (a), (b) or (c) above.
- (3) The rules may contain such incidental and supplementary provisions as appear to the Secretary of State to be appropriate and may, in particular, prescribe circumstances in which a person is or is not to be taken to have been guilty of misconduct.
- (4) Rules made under this section shall be made by statutory instrument which shall be subject to annulment in pursuance of a resolution of either House of Parliament.
- (5) The comptroller shall refuse to recognise as agent in respect of any business to which this section applies a person who neither resides nor has a place of business in the United Kingdom, the Isle of Man or another member State of the European Economic Community.

Trade mark agents

282 The register of trade mark agents

- (1) The Secretary of State may make rules requiring the keeping of a register of persons who act as agent for others for the purpose of applying for or obtaining the registration of trade marks; and in this Part a “registered trade mark agent” means a person whose name is entered in the register kept under this section.

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- (2) The rules may contain such provision as the Secretary of State thinks fit regulating the registration of persons, and may in particular—
 - (a) require the payment of such fees as may be prescribed, and
 - (b) authorise in prescribed cases the erasure from the register of the name of any person registered in it, or the suspension of a person's registration.
- (3) The rules may delegate the keeping of the register to another person, and may confer on that person—
 - (a) power to make regulations—
 - (i) with respect to the payment of fees, in the cases and subject to the limits prescribed by rules, and
 - (ii) with respect to any other matter which could be regulated by rules, and
 - (b) such other functions, including disciplinary functions, as may be prescribed by rules.
- (4) Rules under this section shall be made by statutory instrument which shall be subject to annulment in pursuance of a resolution of either House of Parliament.

283 Unregistered persons not to be described as registered trade mark agents

- (1) An individual who is not a registered trade mark agent shall not—
 - (a) carry on a business (otherwise than in partnership) under any name or other description which contains the words “registered trade mark agent”; or
 - (b) in the course of a business otherwise describe or hold himself out, or permit himself to be described or held out, as a registered trade mark agent.
- (2) A partnership shall not—
 - (a) carry on a business under any name or other description which contains the words “registered trade mark agent”; or
 - (b) in the course of a business otherwise describe or hold itself out, or permit itself to be described or held out, as a firm of registered trade mark agents,unless all the partners are registered trade mark agents or the partnership satisfies such conditions as may be prescribed for the purposes of this section.
- (3) A body corporate shall not—
 - (a) carry on a business (otherwise than in partnership) under any name or other description which contains the words “registered trade mark agent”; or
 - (b) in the course of a business otherwise describe or hold itself out, or permit itself to be described or held out, as a registered trade mark agent,unless all the directors of the body corporate are registered trade mark agents or the body satisfies such conditions as may be prescribed for the purposes of this section.
- (4) The Secretary of State may make rules prescribing the conditions to be satisfied for the purposes of this section in relation to a partnership where not all the partners are registered trade mark agents or a body corporate where not all the directors are registered trade mark agents; and the rules may, in particular, prescribe conditions as to the number or proportion of partners or directors who must be registered trade mark agents.

- (5) Rules under this section shall be made by statutory instrument which shall be subject to annulment in pursuance of a resolution of either House of Parliament.
- (6) A person who contravenes this section commits an offence and is liable on summary conviction to a fine not exceeding level 5 on the standard scale; and proceedings for such an offence may be begun at any time within a year from the date of the offence.

284 Privilege for communications with registered trade mark agents

- (1) This section applies to communications as to any matter relating to the protection of any design, trade mark or service mark, or as to any matter involving passing off.
- (2) Any such communication—
 - (a) between a person and his trade mark agent, or
 - (b) for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his trade mark agent,is privileged from disclosure in legal proceedings in England, Wales or Northern Ireland in the same way as a communication between a person and his solicitor or, as the case may be, a communication for the purpose of obtaining, or in response to a request for, information which a person seeks for the purpose of instructing his solicitor.
- (3) In subsection (1) “trade mark agent” means—
 - (a) a registered trade mark agent, or
 - (b) a partnership entitled to describe itself as a firm of registered trade mark agents, or
 - (c) a body corporate entitled to describe itself as a registered trade mark agent.
- (4) It is hereby declared that in Scotland the rules of law which confer privilege from disclosure in legal proceedings in respect of communications extend to such communications as are mentioned in subsection (1).

Supplementary

285 Offences committed by partnerships and bodies corporate

- (1) Proceedings for an offence under this Part alleged to have been committed by a partnership shall be brought in the name of the partnership and not in that of the partners; but without prejudice to any liability of theirs under subsection (4) below.
- (2) The following provisions apply for the purposes of such proceedings as in relation to a body corporate—
 - (a) any rules of court relating to the service of documents;
 - (b) in England, Wales or Northern Ireland, Schedule 3 to the Magistrates' Courts Act 1980 or Schedule 4 to the Magistrates' Courts (Northern Ireland) Order 1981 (procedure on charge of offence).
- (3) A fine imposed on a partnership on its conviction in such proceedings shall be paid out of the partnership assets.
- (4) Where a partnership is guilty of an offence under this Part, every partner, other than a partner who is proved to have been ignorant of or to have attempted to prevent the

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commission of the offence, is also guilty of the offence and liable to be proceeded against and punished accordingly.

- (5) Where an offence under this Part committed by a body corporate is proved to have been committed with the consent or connivance of a director, manager, secretary or other similar officer of the body, or a person purporting to act in any such capacity, he as well as the body corporate is guilty of the offence and liable to be proceeded against and punished accordingly.

286 Interpretation

In this Part—

“the comptroller” means the Comptroller-General of Patents, Designs and Trade Marks;

“director”, in relation to a body corporate whose affairs are managed by its members, means any member of the body corporate;

“the European list” means the list of professional representatives maintained by the European Patent Office in pursuance of the European Patent Convention;

“registered patent agent” has the meaning given by section 275(1);

“registered trade mark agent” has the meaning given by section 282(1).